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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/315,599	05/20/1999	RITU SHRIVASTAVA	ALSC-00300	6720

28960 7590 11/08/2002  
HAVERSTOCK & OWENS LLP  
162 NORTH WOLFE ROAD  
SUNNYVALE, CA 94086

EXAMINER
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HA, NATHAN W

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/315,599

Applicant(s)

SHRIVASTAVA, RITU

Examiner

Nathan W. Ha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Examiner agreed to withdraw the Advisory Action, paper 16.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case the limitation "wherein the first isolation technique and the second isolation technique are different and **implemented sequentially**" renders new matter situation. Please address this matter in the next communication paper.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoo et al. (US. 5,605,853, previously cited), in view of Mehta (US. 5,679,559, previously cited.).

In regard to claims 1, 5, and 9, and accordance to 112 rejections above, in fig. 7, Yoo et al. discloses a common substrate 10;

an SRAM device 50 implemented on the common substrate and isolated by LOCOS isolation technique 12; and

a flash EPROM device 70 implemented on the common substrate 10 and isolated by LOCOS isolation technique 12.

Yoo et al., however, does not expressly disclose a second isolation technique such as STI to isolate the devices. Mehta, in fig. 18, teaches a first and second isolation techniques 242, 240 to separate the devices on the same substrate in order to scale the minimum spacing between regions, please see col. 6, last paragraph.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use STI isolation technique as taught by Mehta in Yoo et al. substrate in order to scale the minimum spacing between regions.

In regard to claims 2-3 and 7-8, Mehta discloses the first technique is the STI technique and the second isolation technique is LOCOS isolation, as discussed in claim 1 above.

In regard to claims 4, 6, and 10, Yoo et al. discloses SRAM coupled EPROM for transmitting signals, see fig. 7.

Regarding the processing limitations recited in (claims 1, 5, and 9) (implemented sequentially, etc.), this would not carry patentable weight in this claim drawn to structure. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

### ***Response to Arguments***

6. Applicant's arguments filed 9/24/02 have been fully considered but they are not persuasive. For instant, in response to the applicant's arguments, on pages 5-6, the applicant repeatedly submits, "Yoo does not teach or suggest that a SRAM and an EEPROM can be formed on the same IC, using non-LOCOS isolation process, such as a shallow isolation (STI) process. Nor does Yoo teach or suggest that a SRAM and an EEPROM can be formed on the same IC, using a combination of a LOCOS and STI isolation process." As addressed in the previous Official Action, The combination of Yoo and Mehta teaches the technique of using LOCOS and STI isolations. The LOCOS and STI apparently are different. Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, applicant argues about the limitations of a method of making the device, on pages 5-6. It is noted that applicant elected the device claims in the previous amendment, paper 15. The method claims, Group II, therefore, has been withdraw from the examination. Therefore, the discussion regarding limitations in the method of

making the device has nothing to do with the previous Official Action, nor this paper. The newly added limitation such as implemented sequentially also is process limitation, see above discussions. Please focus to the limitations in the pending claims that have been addressed in the Official Actions only in order to eliminate any confusion in the next communication paper.

### ***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Ha whose telephone number is (703) 305-3507. The examiner can normally be reached on M-TH 8:00-7:00(EST).

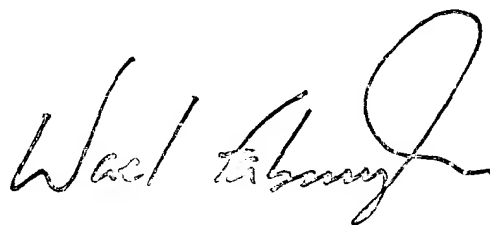
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on (703) 306-2794. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and 308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Nathan Ha  
November 4, 2002

A handwritten signature in black ink, appearing to read "Wael Alkhoury". The signature is fluid and cursive, with a large loop at the end.

SUPERVISORY PRIMARY EXAMINER  
TECHNOLOGY CENTER 2800